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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/016,960	12/07/2001	Eric Verschueren	214598	7343

23460 7590 07/18/2003

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EXAMINER

FUNK, STEPHEN R

ART UNIT

PAPER NUMBER

2854

DATE MAILED: 07/18/2003

8

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/016,960

Applicant(s)

VERSCHUEREN ET AL.

Examiner

Stephen R Funk

Art Unit

2854

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

The disclosure is objected to because of the following informalities: On page 13 line 2 "rests" should be --rest--. Appropriate correction is required.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The disclosure does not support the recitation in claim 7 of the "ink and fountain solution" being sprayed or jetted onto the substrate. Presumably, the "solution" originally recited in claim 7 was the hydrophobic thermoplastic particle solution recited in claim 1 step (a), not the ink and fountain solution recited in claim 1 step (c). See the paragraph bridging pages 8 and 9 in the specification, for example.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 - 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vermeersch et al. (EP 802,457) in view of Nussel et al. (US 5,816,161) and Timpe et al. (US 5,698,360). Vermeersch et al. teach the method as recited with exception of treating the recycled substrate with an aqueous acid solution. See the entire document of Vermeersch et al., in particular, column 2 lines 54 - 57, column 4 lines 5 - 10, column 7 lines 4 - 18, and column 10 lines 47 - 51. Nussel et al. teach the conventionality of applying both a cleaning liquid and a refreshing

liquid on a reusable substrate. See column 4 lines 3 - 12 of Nussel et al., for example. Timpe et al. teach the conventionality of a refreshing liquid consisting of an aqueous solution of phosphoric acid (which inherently has a  $\text{pH} < 7$ ). See column 7 lines 41 - 51 of Timpe et al., for example. It would have been obvious to one of ordinary skill in the art to provide the method of Vermeersch et al. with the step of treating the recycled substrate with an aqueous acid solution in view of Nussel et al. and Timpe et al. so as to increase the hydrophilicity of the cleaned substrate. With respect to claim 2 see column 7 line 19+ of Vermeersch et al. With respect to claims 3 and 4 note the phosphoric acid of Timpe et al. With respect to claims 5 and 7 note column 4 lines 5 - 10 of Vermeersch et al. With respect to claim 6 see column 3 lines 1 - 4 of Vermeersch et al.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note the Abstract of Kimura et al. ('075), column 6 lines 34 - 62 of Verschueren et al. ('036), column 3 lines 31 - 45 of Hirt et al. ('318), the Abstract and the paragraph bridging columns 3 and 4 of Dixit et al. ('481), column 2 lines 24 - 52 and Example 12 of Brown ('008), and column 5 lines 1 - 4 of Lind et al. ('886).

Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

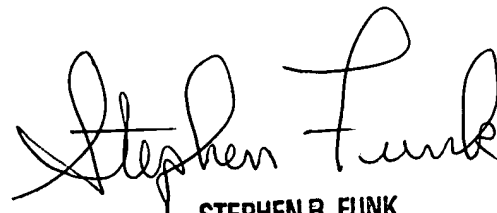
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen Funk at telephone number (703) 308-0982. The examiner can normally be reached Monday - Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Drew Hirshfeld, can be reached at (703) 305-6619.

The fax number for *official* papers is (703) 308-7722, 7724. The fax number for those wishing an auto-reply verifying receipt of *official* papers is (703) 872-9318 or for After-Final actions is (703) 872-9319. Upon consulting with the examiner *unofficial* papers only may be faxed directly to the examiner.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist at telephone number (703) 308-0956.

Stephen Funk  
July 14, 2003



STEPHEN R. FUNK  
PRIMARY EXAMINER